



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/646,724	09/04/84	STUETZ	700-72537-1

GERALD D. SHARKIN  
SANDOZ, INC.  
59 ROUTE 10  
E. HANOVER, NJ 07936

EXAMINER	
FINESYK	
ART UNIT	PAPER NUMBER
1.2.9	13

DATE MAILED: 09/14/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 5/18/87 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~days~~ from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449                  | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474      | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 3-5, 9-13 and 18-23 are pending in the application.  
Of the above, claims 9 and 19-23 are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 3-5, 10-13 and 15-18 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☒ Claims 9 and 19-20 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable;  
☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received

☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

Serial No. 646724

-2-

Art Unit 124

The text of those sections of Title 35 U. S. Code not included in this action can be found in a prior Office action.

Claims 3-5, 10-13, and 15-18 are rejected under 35 U.S.C. 103 as being unpatentable over Hamberger et al ., of record, and Hamberger et al.(I), above cited, which corresponds to Hamberger et al. The primary references does, in fact, specifically set forth a class of compounds which are suggestive of those of the instant claims, i.e. the compounds of the prior art as would be expected are, in fact, useful for the instantly claimed properties as well as the fact that the compounds are also suggested as being interchangeable one/for the other, and moreover, the compounds are also expected to be useful for the instantly recited properties, per se. Granted, the claims of each of the references may in the opinion of the applicants constitute a shot-gun type disclosure this does not negate the specific teachings of the prior art that the compounds would inherently be expected to be useful for the same properties as well as the specific fact that one of average skill in the art would also be motivated to prepare the various derivatives with the expectation that the so-modified compounds would be obviously expected to possess quite similar properties, per se. Applicants' arguments' and declaration have been carefully considered but are not deemed persuasive of any patentable merit over the

Serial No. 646724

-3-

Art Unit 124

teachings of the prior art on the basis that the mere differences in activity is not persuasive of patentable merit, especially since the requirement is based upon unexpected properties and not solely on the basis of increase in a specific expected property, per se. Granted, the reference may not specifically illustrate a complete compound within the scope of the claims but the same does not negate the fact that the artisan is placed in possession of the compound and that the same would be expected to possess similar properties which in the instant fact situation is the expected results. No invention is readily apparent in the instantly claimed compounds and/or the method of use over the teachings of the prior art, especially since only the art expected properties are obtained by following the teachings of the prior art disclosure, per se.

Claims 9 and 19-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a nonelected species. Election was made without traverse in Paper No. 5.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM

Serial No. 646724

-4-

Art Unit 124


THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT V. HINES whose telephone number is (703) 557-7624.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

Hines:pc

8/10/87:retype 8/25/87

  
ROBERT V. HINES  
PRIMARY PATENT EXAMINER  
GROUP ART UNIT 124